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In the
Supreme Court of the United States

LOREN DAVID,

Petitioner,

v.

MONSANTO COMPANY AND
MONSANTO TECHNOLOGIES LLC,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred International, Inc., 534 U.S. 124 (2001), the Supreme Court held that a *35* U.S.C. § 101 patent could be obtained on a plant variety, although Congress had enacted two later, plant-specific statutes, the Plant Variety Protection Act of 1970 ("PVPA"), 7 U.S.C. § 2321 et seq. (which provides that farmer seed saving and plant variety research do not constitute infringement), and the Plant Patent Act of 1930 ("PPA"), 35 U.S.C. §§ 161-164. However, the *J.E.M.* Court instructed that to obtain a § 101 patent on a plant variety (and its accompanying rights of exclusion) an inventor must satisfy § 35 U.S.C. § 112's demanding description requirement by describing the plant variety with sufficient specificity to enable others to make and use the invention after the patent term expires, and must make a deposit of seeds in a depository accessible to the public. The following questions are presented:

1. In view of the Supreme Court's decision in J.E.M., 534 U.S. 124 (2001), do *35* U.S.C. §§ 101 and 112, when read together with the PVPA and PPA, authorize an action for infringement of a § 101 patent on only a DNA sequence that does not describe any plant variety, does not include a publicly accessible deposit of any seed, and does not enable one to make and use any specific plant variety, against a farmer for saving and planting seed of an unidentified plant variety merely because laboratory tests show the presence of the patented DNA sequence in the plant variety?

2. Do Federal Rules of Evidence 803(6) and 703, when read together, allow a party's paid testifying expert to base his testimony on a report of seed tests performed by another of the same party's paid experts *who did not testify* when those tests were performed by the non-testifying expert *for the purposes of the present litigation* and not in the ordinary course of business?

3. Is a federal statutory award of attorney fees, expert expenses, and costs in a private law action (not a civil rights action involving important civil and constitutional rights providing a broader, uncompensated benefit to the public), in the amount of $487,000, reasonable in relation to the result achieved, a compensatory damage award of $226,000 (which was remanded to the District Court on April 21, 2008, for reduction as clearly erroneous, with no decision yet)?

PARTIES TO THE PROCEEDINGS BELOW

Pursuant to Supreme Court Rule 14.1, petitioner states that all parties to the proceedings in the court whose judgment is sought to be reviewed are listed in the caption.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Loren David petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit is reported at 516 F.3d 1009 (Fed. Cir. 2008) and is reproduced in the Appendix at 1a. The reported opinions of United States District Court for the Eastern District of Missouri are at 448 F. Supp.2d 1088 (2006) (App. 44a), 448 F. Supp.2d 1095 (2006) (App. 28a), and 2006 WL 3079059 (App. 22a).

JURISDICTION

The judgment of the Court of Appeals for the Federal Circuit was entered on February 5, 2008 (App. at 1a). The Court of Appeals denied a timely petition for rehearing *en banc* on April 14, 2008. This Court granted an extension of time to August 12, 2008, to file this petition. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS

Pertinent statutory provisions and administrative materials are included in the App. at 61a-71a.

STATEMENT OF THE CASE

1. On April 12, 2004, Respondents, Monsanto Company and Monsanto Technologies, LLC

("Monsanto") sued Petitioner Loren David ("David") in the United States District Court for the Eastern District of Missouri claiming David infringed Patent No. 5,352,605 ("'605 patent") by planting in the crop year 2003 soybean seed David allegedly saved from the crop he harvested in 2002. David denied the charge and to this day maintains he is innocent. The District Court had jurisdiction under 28 U.S.C. § 1338(a) because this is a civil action arising under the United States patent laws.

2. "Roundup Ready" (also "RR") is Monsanto's trade name for seed that laboratory tests show contains the DNA sequence that is the subject of the '605 patent.

3. *McFarling v. Monsanto Co.*, 363 F.3d 1336, 1339 (Fed. Cir. 2004), *cert. denied*, 545 U.S. 1139 (2005), describes the '605 patent:

> United States Patent No. 5,352,605 ("the '605 patent") relates to the use of a particular promoter in genetically modified plant cells. The '605 patent claims, *inter alia*, DNA sequences and plant cells containing the promoter. A promoter sequence is a DNA sequence located in proximity to the DNA sequence that encodes a protein and that, in part, tells the cellular machinery how much of the protein to make.

Timothy Conner, Monsanto Senior Director, Oil Seeds and Food Technology, testified that: nowhere does the '605 patent describe any specific plant variety; a person knowledgeable in the art of plant breeding

cannot take the information in the '605 patent and know how to grow any specific plant variety; and there was no publicly accessible deposit of any seed of a specific soybean plant variety that was made in conjunction with the '605 patent. (Fed. Cir. App. 86-89, 90-91, 91-92)

4. The District Court entered judgment September 14, 2006, against David for $787,000 plus post-judgment interest: $226,214.40 compensatory damages; $10,000 enhanced damages; $323,140.05 attorney fees; $164,608.03 costs and expert expenses; $63,026.95 prejudgment interest. (App. 26a)

5. In 2003, a unit of RR soybean seed purchased at the seed store cost $21. Out of that Monsanto received a $7.75 "tech fee." The remainder of the $21 went to the seed company that produced and owned the specific soybean plant variety, and to the seed store that sold it.

6. Monsanto's retained expert Mark Hoffman testified he did not know what revenue Monsanto lost per unit of saved seed or whether it exceeded the $7.75 tech fee, and that he could have quantified that but was not asked by Monsanto to do so. (Fed. Cir. App. 179-180)

7. Hoffman testified that David by planting saved seed would have lost $12 from extra cost/lost yield compared to planting new purchased seed, and therefore would have saved only $9 per unit of saved seed planted ($21 - $12 = $9). (Fed Cir. App. 184-185)

8. The District Court found David in 2003 planted 4,110 units of infringing saved RR seed (remanded for reduction, *supra*, n. 1). This amounts to a loss to Monsanto of $31,852.50 in "tech fees." (4110 x $7.75 = $31,852.50) It amounts to a gain by David, after extra saved seed expenses, of $36,990. (4110 x $9 = $36,990) The judgment is $787,000 (plus post-judgment interest), which is over 100 times the only actual revenue loss ($7.75 tech fee) Monsanto proved.

9. Shortly after the expert witness deadline in November 2004, David and his prior counsel severed their relationship. While unrepresented, David commissioned independent plant variety testing to prove what specific plant varieties were represented in the seed samples Monsanto took from David's plowed fields in April 2004 (long after the 2003 growing season and after David routinely discarded his planting records). He testified he did so because he knew what the tests would show. These tests showed that the only RR soybean variety David ever planted before 2003, the 2070 RR variety that he legally bought and planted in 2002, *was not* in Monsanto's seed samples. Further, the plant variety tests showed the three RR soybean varieties Monsanto concedes David legally purchased in 2003 *were* in the Monsanto samples of seed grown in David's fields in 2003. (Fed. Cir. App. A587-583) The variety test dendogram shows the genetic distance between 2070 RR and Monsanto's seed samples is far greater than the genetic distance between the samples and the three varieties David legally purchased in 2003. (Fed. Cir. App. 582) The variety tests exonerate David.

10. David's present counsel was retained shortly before the discovery deadline (extended once when David was unrepresented). David's motion for leave to take a deposition of the expert who performed the plant variety tests exonerating David was denied because he was not designated and the test results were excluded because the expert performing the tests (Russell Rasmussen, Ph.D., STA Laboratories, Longmont, CO) could not testify to provide foundation. Monsanto objected: "Moreover, Defendants' request is futile because this Court has already excluded any evidence or testimony from ... Dr. Rasmussen which necessarily includes the documents that contain [his] test results and/or opinions." (Plaintiff's Opposition to Defendant's Motion for Reconsideration, p. 1, Dist. Ct. Docket 84) Monsanto's objection was based on the fact Dr. Rasmussen performed the plant variety tests for purposes of litigation. "Defendant did not send the alleged 2003 soybean samples to these individuals or their employers in the ordinary course - he sent them as part of his defense of this litigation."

11. One of Monsanto's paid experts was Fritz Koppatschek, Director of Ag Sampling for the company Agri Business Group/Ag Sampling Service. (Fed. Cir. App. 56) Another Monsanto paid expert, Brian Ojala, Director of Bio Lab Solutions, after suit was filed performed *for purposes of this litigation* molecular biological testing on the seed samples Monsanto alleged it took from David's fields in April, 2004. BioLab Solutions is part of Agri Business Group, which has been paid 2.4 million dollars by Monsanto on this and other cases. (Fed. Cir. App. 149A, 162 A-163) *Ojala did not testify*. His written report of seed testing activities was nevertheless admitted, over

objection based on Federal Rules of Evidence 803(6) and 703, through the testimony of Koppatschek. Koppatschek's report incorporated Ojala's three-page seed test report. (App. 72a-80a; Exhibit 358, Fed. Cir. App. 48-52) Koppatschek himself authored only two sentences relating to the seed tests:

> Lab Analysis
>
> After review lab results, all soybean fields sampled tested positive for the CP4 EPSPS protein associated with the Roundup Ready gene. These fields totaled 2106.5 acres.

(Fed. Cir. App. 49)

12. The Federal Circuit Panel issued its opinion on February 5, 2008, affirming the District Court's judgment, with one exception. The $226,000 compensatory damage award was remanded for reduction because the seed planting rate used by the District Court was clearly erroneous. *David v. Monsanto Company*, 516 F.3d 1009, 1019 (Fed. Cir. 2008). There has been no decision yet on the remanded issue. Rehearing *en banc* was denied April 14, 2008.

13. The Federal Circuit Panel based its ruling of infringement on its conclusion that "....Monsanto presented [nontestifying] Ojala's scientific field tests demonstrating that David's soybean fields have been planted exclusively with RR soybeans....". These were DNA sequence tests only, *not plant variety tests*. Ojala's test conclusions that the '605 gene sequence was present in every seed sample tested was one of

"three *crucial* pieces of evidence" necessary to prove Monsanto's claim of infringement. (Monsanto Fed. Cir. Brief at 10; emphasis added) Ojala's test conclusions were "crucial" because Monsanto's theory was that though David had legally purchased RR seed in 2003 it was not enough to explain Ojala's tests.

14. Over $487,000 in attorney fees, expert expenses, and costs were awarded for achieving only a $226,000 compensatory damage award that was remanded for reduction.

REASONS FOR GRANTING THE WRIT

I. This Court Should Review Whether 35 U.S.C. §§ 101 and 112, When Read Together with the Plant Variety Protection Act of 1970 and Plant Patent Act of 1930, Authorize an Action for Infringement of a § 101 Patent on Only a DNA Sequence That Does Not Describe Any Plant Variety, Does Not Include a Publicly Accessible Deposit of Any Seed, and Does Not Enable One to Make and Use Any Specific Plant Variety, Against a Farmer for Saving and Planting Seed of an Unidentified Plant Variety Merely Because Laboratory Tests Show the Presence of the Patented DNA Sequence in the Plant Variety

A. The question is important.

The Court of Appeals for the Federal Circuit has exclusive appellate jurisdiction over patent decisions of all federal district courts (except for patent issues arising only in a counterclaim). The Federal Circuit

denied rehearing *en banc* and therefore the Panel's decision becomes the entrenched position of the Federal Circuit, binding on federal district courts throughout the nation.

Supreme Court Practice, Gressman, Geller, Shapiro, Bishop and Hartnett, 9th Ed., 2007, states at 287:

> Importance may be found in the Federal Circuit's treatment of patentability standards, or in its treatment of an exceptionally significant patent, or in its application of prior Supreme Court precedent, or in its treatment of combination patents - to mention some of the more obvious factors. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007); *Merck KGaA v. Integra Lifesciences I, Ltd.*, 545 U.S. 193 (2005); *J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124 (2001); *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 89 (1993).

The Federal Circuit's decision on this issue triggers the first three of these four "more obvious factors." The decision involves treatment of patentability standards (first factor) because its practical effect is to allow an inventor to enforce patent exclusion rights against a farmer for any plant variety that laboratory tests show contains the inventor's patented DNA sequence even though the inventor has no patent on the plant variety. The decision allows this even though the DNA patent does not describe the plant variety, does not make a publicly accessible deposit of seed, and thus does not enable one skilled in the art to

make and use the plant variety at the expiration of the patent monopoly (¶ 3, p. 2, *supra*).

The decision also involves an exceptionally important patent (second factor). Ninety percent of U.S. soybean acres are planted in soybean plant varieties that test positive in a laboratory for the '605 patented DNA sequence. (Monsanto's Federal Circuit Brief, p. 3). Thus, the Federal Circuit's decision granting the '605 DNA patent vastly expansive rights of exclusion against farmers applies to nearly all soybean fields in the nation.

The third factor is clearly triggered because the Federal Circuit's decision is in stark conflict with *J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124 (2001) (cited above, page 8, in Supreme Court Practice at 287). The Federal Circuit's misinterpretation of *J.E.M.* is a conflict with Supreme Court precedent that is both direct and readily apparent. In 1980 the Supreme Court in *Diamond v. Chakrabarty*, 447 U.S. 303, 313, held that 35 U.S.C. § 101 [App. 66a] was expansive enough to allow patents on living things (there a man-made micro-organism). Following *Chakrabarty*, the Court in *J.E.M.* held that the existence of two later enacted, plant specific statues, the Plant Patent Act of 1930 ("PPA") 35 U.S.C. §§ 161-164 [App. 67a-68a], and the Plant Variety Protection Act of 1970 ("PVPA"), 7 U.S.C. § 2321, et seq. [App. 61a-65a], did not necessarily preclude issuance of a § 101 patent on a plant variety. 534 U.S. at 142-143. However, *J.E.M.* instructs that to obtain a patent on a plant variety (and its accompanying rights of exclusion) an inventor "must satisfy § 101's demanding description

requirement ..." [at 134], "must describe the plant with sufficient specificity to enable others to 'make and use' the invention after the patent term expires ..." [at 142], and must make "a deposit of biological material, for example, seeds, [in a depository] accessible to the public [at 142]." The Federal Circuit's decision below, however, accords the '605 patent the same rights of exclusion held by a patent on a plant variety, yet the '605 DNA patent describes no plant variety, includes no publicly accessible seed deposit, and does not even claim a plant variety.

Certiorari is often granted to clarify a matter where it is charged that the court of appeals has misconstrued an applicable Supreme Court opinion (*Elder v. Holloway*, 510 U.S. 510, 515 (1994); *SEC v. Edwards*, 543 U.S. 389, 392-393 (2004)), or misapprehended a Supreme Court opinion (*Schlude v. Commissioner*, 372 U.S. 128, 130 (1968)), or misconceived a Supreme Court opinion (*Wilkinson v. United States*, 365 U.S. 399, 401 (1961)), or where the Court of Appeals decision "appeared to be in conflict with our precedents" (*Army Air Force Exchange Service v. Sheehan*, 456 U.S. 728, 733 (1982)). "Where the decision of the Court of Appeals clearly fails to apply prior Supreme Court decisions because of error or oversight, the Court usually grants certiorari. *See, e.g., Fullers v. United States*, 540 U.S. 519 [524-525] (2004) ..." *Supreme Court Practice* at 250.

The very best possible light that can be shown upon the Federal Circuit's decision would be a contention that the Supreme Court's language in *J.E.M.* may be ambiguous when applied to a situation the *J.E.M.* court did not have in mind: suing a farmer for

infringing a DNA sequence patent. This too would merit a grant of the writ. *See Gonzaga University v. Doe*, 534 U.S. 273, 278 (2002).

B. The Federal Circuit decided the question incorrectly.

When the Supreme Court decided *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred International, Inc.*, 534 U.S. 124, 140-141 (2001), the court recognized that Congress in enacting the PPA and the PVPA intended that farmers be treated differently. *See*, 534 U.S. at 132-133, 138-140. The court therefore construed the PPA, the PVPA and § 101 together. 534 U.S. at 143-144; and at 146 (J. Scalia concurring). That is why in *J.E.M.* the court emphasized as the basis for its holding that a § 101 patent could be granted on a *plant variety* but it "must satisfy § 101's demanding description requirement." 534 U.S. at 134.

Before enacting the PVPA, the federal government engaged in a great deal of study concerning extending federal protection to sexually reproducing plant varieties. On July 23, 1965, a presidential commission was appointed to review the operation of the United States patent system. It spent eighteen months accomplishing this review. Patent Law Revision Hearings, Subcommittee on Patents, Trademarks and Copyrights, Senate Judiciary Committee, 90th Cong. 2nd Sess., 1968, Part 3, p. 648. One recommendation of the presidential commission was that all provisions in the patent law for plant patents be deleted. *Id.* The U.S. Department of Agriculture opposed a proposed amendment to expand the coverage of 35 U.S.C. §§ 161-164 to include sexual reproduction of plants.

Id. at 715. These references are offered to remind us of the extent of the continuing political debate that preceded the passage of the 1970 PVPA.

In *J.E.M.*, the U.S. Supreme Court held that the PPA and the PVPA do not provide the exclusive means for obtaining federal statutory protection of plant varieties, and that the other means of obtaining federal statutory protection of a plant variety is a 35 U.S.C. § 101 utility patent on a *plant variety*. 534 U.S. at 140-143. The '605 patent claims and describes a DNA sequence, not a plant variety (¶ 3, p. 2, *supra*). However, the court in *J.E.M.* explained, at 534 U.S. 131, that to obtain a § 101 patent on a plant variety "...the patent must meet the specifications of § 112 [App. 66a], which require a written description of the plant and a deposit of seed that is publicly accessible. See 37 CFR §§ 1.801-1.809 (2001)."

The relaxed written description requirements of the PVPA and PPA require that the plant variety description be "as complete as possible." 7 U.S.C. § 2422(2); 35 U.S.C. § 162. [App. 67a] The *J.E.M.* court said that on the other hand a § 101 patent on a *plant variety* "must satisfy § 101's demanding description requirement." 534 U.S. at 134. The court in *J.E.M.* concluded that the PVPA and PPA are not statutory bars to granting § 101 patents on plant varieties because it is harder to obtain a § 101 patent on a plant variety: "Because it is harder to qualify for a utility patent than for a plant Variety Protection (P.V.P.) certificate, it only makes sense that utility patents would confer a greater scope of protection." 534 U.S. at 138. The PVPA exemptions for seed saving (7 U.S.C. § 2543; App. 65a) and research (7 U.S.C.

§ 2544; App. 65a) do not apply to a § 101 patent on a *plant variety* because the § 101 patent is more difficult to obtain. 534 U.S. at 140, 142 [App. 66a].

In *J.E.M.* the more stringent § 112 written description requirement for obtaining a §101 patent on a *plant variety* is the core of the Court's reasoning leading to the conclusion that the PPA and the PVPA do not evidence a Congressional intent that a §101 patent can never issue *on a plant variety*. At 534 U.S. 142-143, the Court explained:

> It is much more difficult to obtain a utility patent for a plant than to obtain a PVP certificate because a utility patentable plant must be new, useful, and nonobvious, 35 U.S.C. §§101-103. In addition, to obtain a utility patent, a breeder must describe the plant with sufficient specificity to enable others to "make and use" the invention after the patent term expires. §112. The disclosure required by the Patent Act is "the *quid pro quo* of the right to exclude." [citation omitted]. The description requirement for plants includes a deposit of biological material, for example, seeds, and mandates that such materials be accessible to the public. See 37 CFR §§ 1.801-1.809 (2001); see also App. 39 (seed deposits for the U.S. Patent No. 5,491,295).
>
> ....Nor does the PVPA require a description and disclosure as extensive as those required under § 101....

> Because of the more stringent requirements, utility patent holders receive greater rights of exclusion than holders of a PVP certificate. Most notably, there are no exemptions for research or saving seed under a utility patent.

534 U.S. at 142-143; *see also* 534 U.S. at 143-144.

Nothing in the Court's analysis in *J.E.M.* supports the Federal Circuit's position that an action for infringement against a farmer who allegedly saves seed and replants it on his own farm can be based on a patent on a DNA sequence, like the '605 patent, which does not claim seeds or plants, contains no specific description of a *plant variety*, and does not include any deposit of seed accessible to the public (¶ 3, *supra*, p. 2).

The Federal Circuit Panel sets out its holding at 516 F.3d 1014:

> Contrary to David's argument on appeal, nothing in *J.E.M.* invalidates or limits the '605 patent or any utility patent on a gene sequence in a seed or a plant. In fact, in *J.E.M.*, the Supreme Court explicitly refused to limit the extent of patentable subject matter: "we decline to narrow the reach of § 101 where Congress has given us no indication that it intends this result." *J.E.M.*, 534 U.S. at 146-47, 122 S.Ct. 593. The '605 patent covering the gene sequence is infringed by planting a seed containing the gene sequence because the seed contains the gene. The gene itself is being used in the planting, an infringing act.

The Panel misinterpreted the *J.E.M.* Court's intent when it said, "we decline to narrow the reach of § 101 where Congress has given us no indication that it intends this result." The *J.E.M.* Court there was speaking to whether a plant variety *could ever* be the subject of a § 101 patent. The Court was not saying that the PVPA and the PPA do not inform us of the intent of Congress as to what is required of an inventor to obtain a patent on a *plant variety*. The intent of Congress can be determined only by reading all three statutes together. *J.E.M.* at 534 U.S. 143-44 and at 146 (Justice Scalia's concurrence); *Food and Drug Administration v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 132-33 (2000).

The *J.E.M.* majority opinion, concurring opinion, and dissent, all had one thing in common. They were all deciding whether Congress intended to allow the grant under § 101 of a patent on a *plant variety*. Nowhere in any of the *J.E.M.* opinions is there even an implication that, as the Federal Circuit held, the owner of a patent that does not describe a *plant variety* under § 112 can nevertheless recover damages from a farmer for exercising the age-old right to save seed from a plant variety.[1]

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[1] When the 1994 PVPA Amendments removed from 7 U.S.C. § 2543 the right of a farmer to sell saved seed, the House Report (Agricultural Committee) No. 103-699, Aug. 12, 1994 (To Accompany H.R. 2927), provided in Section 10, p. 17: "It is not the intent of the Committee that deletion of the provision allowing the sale of saved seed to be viewed as a step toward the eventual end to the traditional right of farmers to save seed for use on their own holdings."

Justice Scalia's analysis in his concurring opinion in *J.E.M.* is instructive:

> This case presents an interesting and difficult point of statutory construction, seemingly pitting against each other two perfectly valid canons of interpretation: (1) that statutes must be construed in their entirety, so that the meaning of one provision sheds light upon the meaning of another; and (2) that repeals by implication are not favored. I think these sensible canons are reconcilable only if the first of them is limited by the second.

534 U.S. at 146. Justice Scalia decided it had been resolved that § 101 covered the subject matter of living things and thus covered plants, so he concurred with the majority, which upheld granting a § 101 patent that *described a plant variety*. *Id.* at 146-147.

Now that *J.E.M.* has decided that the right to obtain a § 101 patent on a *plant variety* was not repealed by implication by passage of the PPA and PVPA, Justice Scalia's first canon of interpretation must be followed. The PPA, PVPA and § 101 and § 112 must be construed together. Thus, in deciding whether a § 101 patent that *does not* describe a *plant variety* can support an infringement action against a farmer for seed saving, 35 U.S.C. §§ 101 and 112 must be read together with the PPA and PVPA. *Food and Drug Admin. v. Brown & Williamson Tobacco Corp.*, 529 U.S. 120, 132-133 (2000). The Court in *J.E.M.* said at 534 U.S. 143-144:

> The plain meaning of § 101, as interpreted by this Court in *Chakrabarty*, clearly includes plants within its subject matter. The PPA and the PVPA are not to the contrary and can be read *alongside § 101 in protecting plants*.

The PPA and PVPA construed together with 35 U.S.C. §§ 101 and 112 show the intent of Congress to treat federal protection of plant varieties differently than federal protection of living things that are not plants and not produced by farmers. *See*, 534 U.S. at 132-133, 138-140. *J.E.M.* makes clear that the extent of federal protection of plant varieties depends on the extent of the patent holder's ability to particularly describe the plant variety and deposit its seed. A patent describing only a DNA sequence, like the '605 patent, does not fit within this statutory scheme. Monsanto argued below that the '605 patent covers "any plant or seed that contains such a gene, just as a patent on a drug covers any pill in which the drug is an active ingredient." Such analogies are inapposite where, unlike plants, there are no pill-specific, later enacted federal statutes (like the PVPA and PPA) specifically designed to protect pills that exist alongside 35 U.S.C. §§ 101 and 112, and which therefore would inform the determination of Congress' intent in extending federal protection to pills. Congress has treated plant varieties, and farmers, specifically and differently.

The PVPA's infringement provisions apply to "any variety that is essentially derived from a protected variety. . . ." 7 U.S.C. § 2541(c)(1) (added by 1994 PVPA Amendments, Pub. L. 103-349, § 9(3)). Section 2401(a)(3)(B) provides:

> Methods
>
> An essentially derived variety may be obtained by the selection of a natural or induced mutant or of a somaclonal variant, the selection of a variant individual from plants of the initial variety, backcrossing, *transformation by genetic engineering*, or other method. [Emphasis added.]

[App. 62a]

The *J.E.M.* Court knew Congress has provided that PVPA protection can extend to plant varieties created through the use of "genetic engineering." Thus, the PVPA provides alternative federal protection to developers of bioengineered plant varieties who cannot meet the § 101 stringent description and seed deposit requirements. The Court in *J.E.M.* accordingly did not except genetically engineered plant varieties from the stringent written description and seed deposit requirement for obtaining a § 101 patent on a *plant variety*.

If Monsanto was required to prove, as an element of infringement by a farmer, that a specific patented plant variety was in his fields and that he planted that specific variety the prior year, Monsanto would have to perform plant variety tests to prove infringement. (David commissioned his own variety tests to exonerate himself, but they were excluded. ¶¶ 9-10, *supra*, pp. 4-5.) The Federal Circuit's position allows Monsanto to test only for the presence of the '605 patent's DNA sequence and then launch a barrage of lawyers and experts ($487,000 in Petitioner's case

through trial) to build a documentary circumstantial evidence case.

On the other hand, Monsanto admitted it could protect its RR technology by employing a system coupling its '605 DNA patent with § 101 patents on specific *plant varieties*. Monsanto's witness Doug Dorsey is the U.S. business leader for Monsanto's Asgrow and DeKalb seed businesses. Dorsey testified that Monsanto could refuse to license inserting the '605 patent material in any *plant variety* that is not protected by a § 101 utility patent. Dorsey admitted it would be possible to use a § 101 patent on a *plant variety* to prohibit others from planting saved seed just as Monsanto now does with its '605 patent on a DNA sequence. Dorsey testified that if the law is that the only way a limited license can be used is in conjunction with a patent on a specific plant variety, then Monsanto would consider that in marketing its '605 patent material. Dorsey said the downside for Monsanto of using a patent on a plant variety to restrict use is that "it's a lot more difficult to test for individual varieties than it is to test for the gene." Of course, the converse is that it is a lot more difficult for a farmer to defend against Monsanto's lawyer and expert intensive circumstantial evidence patent prosecution that is based only on a test for the *DNA sequence*, not on proof of saving and planting a *specific patented plant variety*.

Use of a § 101 patented DNA sequence by a competitor in a laboratory to insert the patented sequence into plant tissue is infringement of the '605 patent. Dorsey's testimony acknowledges that the holder of a patented DNA sequence can control this

laboratory step to license use of the DNA sequence only in specific plant varieties that are protected by a § 101 patent. Thus, reading §§ 101 and 112 together with the PVPA and PPA to require that an action against a farmer for seed saving be based on a § 101 patent *on a plant variety* is compatible with enforcement of a § 101 patent on a DNA sequence.

II. This Court Should Review Whether Federal Rules of Evidence 803(6) and 703, When Read Together, Allow a Party's Paid Testifying Expert to Base His Testimony on a Report of Seed Tests Performed by Another of the Same Party's Paid Experts Who Did Not Testify When Those Tests Were Performed by the Non-testifying Expert for the Purposes of the Present Litigation and Not in the Ordinary Course of Business.

A. The question is important.

Like the '605 patent issue, the Federal Circuit's denial of an *en banc* rehearing makes the Panel's decision on this question the entrenched position of the Federal Circuit. The decision conflicts with *Palmer v. Hoffman*, 318 U.S. 109, 114 (1943), which held that a report prepared *for the purpose of the litigation* is not admissible under the relaxed standards applied to business records. The Federal Circuit upheld the District Court's admission of '605 DNA seed tests performed by Monsanto paid expert Brian Ojala *for the purposes of litigation*, over David's objection that *Ojala did not testify*. (¶¶ 10-11, 13, *supra*, p. 5-7) This conflict with *Palmer* is a factor showing the issue is important. (*Supreme Court Practice* at 287, *supra*, p. 8).

A conflict between a decision of the Federal Circuit on general federal law and another circuit court of appeal "is a basis for Supreme Court review of either decision by way of certiorari." *Supreme Court Practice* at 255. The Federal Circuit affirmed the District Court's admission, over David's objection, not only of the Ojala tests but also the testimony of Monsanto paid expert Fritz Koppatschek regurgitating the inadmissible test conclusions. (¶¶ 11, 13, *supra*, p. 5-7) Allowing admission of an expert report prepared *for purposes of litigation* without presenting the authoring expert for cross-examination, and allowing another paid expert to testify to the inadmissible hearsay report's conclusions, conflicts with decisions of the Eighth, Fourth and Seventh Circuits.

A circuit court decision in conflict with the clear requirements of the Federal Rules of Criminal Procedure, Civil Procedure or Evidence also merits certiorari review in exercise of the Supreme Court's judicial supervision duty. *See: McNabb v. United* States, 318 U.S. 332, 340-341 (1943) ("Judicial supervision of the administration of criminal justice in the federal courts" includes the duty of maintaining "standards of procedure and evidence"); *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 141 (1999) (granting certiorari to clarify trial judge's gate keeping obligation in admission of expert testimony under FRE 702). The interplay between FRE 803(6) and FRE 703 arises in countless district court cases across the nation. The necessity of the Supreme Court issuing a decision clarifying the interplay between these two rules of evidence is of widespread importance.

B. The Federal Circuit decided the question incorrectly.

Issues on the admissibility of evidence in the Federal Circuit appeal below are governed by the decisional law of the Eighth Circuit Court of Appeals. *Wang Laboratories, Inc. v. Applied Computer Sciences, Inc.*, 958 F.2d 355, 357 (Fed. Cir. 1992). The Federal Circuit's approval of Koppatschek's expert testimony based on conclusions of *another nontestifying expert about tests the nontestifying expert performed for purposes of litigation* on seed samples resulted from an erroneous view of the interplay between Federal Rules of Evidence 803(6) and 703.

In *Palmer v. Hoffman*, 318 U.S. 109, 114 (1943), the court affirmed the trial court's decision that a report about a train accident made by the locomotive engineer subsequent to the accident was not admissible under the business record hearsay exception. The court explained:

> In short, it is manifest that in this case those reports are not for the systematic conduct of the enterprise as a railroad business. Unlike payrolls, accounts receivable, accounts payable, bills of lading and the like these reports are calculated for use essentially in the court, not in the business. Their primary utility is in litigating, not in railroading.[2]

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[2] "*Palmer* was decided under what is sometimes called the Business Records Act then in effect, 28 U.S.C. § 695, which was not different in any respect pertinent here from § 803(6)." *Certain*

The Eighth Circuit Court of Appeals applies the same rule. In *Scheerer v. Hardee's Food Sys. Inc.*, 92 F.3d 702, 706-07 (8th Cir. 1996), *appeal after remand*, 148 F.3d 1036 (8th Cir. 1998), *cert. denied*, 525 U.S. 1105 (1999), the court said:

> In addition, the incident report was inadmissible as a business record under Fed.R.Evid. 803(6) because it had been prepared in anticipation of litigation. Even if we assume that Mrs. Fran was the source of the information about Mrs. Scheerer's shoes, the incident report lacks reliability or trustworthiness because it was not made in the ordinary course of business but instead with the knowledge that the incident could result in litigation. *e.g., United States v. Blackburn*, 992 F.2d 666, 670 (7th Cir.) (lensometer report prepared at behest of FBI and with knowledge that any information it supplied would be used in ongoing criminal investigation was not prepared and kept in ordinary course of eyeglasses business), *cert. denied*, 510 U.S. 949, 114 S.Ct. 393, 126 L.Ed.2d 341 (1993); *Picker X-ray Corp. v. Frerker*, 405 F.2d 916, 922-23 (8th Cir. 1969) (hospital report made by business manager after accident which he knew could

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Underwriters at Lloyd's, London v. Sinkovich, 232 F.3d 200, 205, n. 3 (4th Cir. 2000). *Certain Underwriters* also cites at 232 F.3d 205, "*Scheerer v. Hardee's Food Sys. Inc.*, 92 F.3d 702, 706-07 (8th Cir. 1996) (stating that a report lacks trustworthiness because it was made with knowledge that incident could result in litigation)."

> result in litigation was not used for treatment or any other ordinary business purpose but instead with knowledge that incident could result in litigation).

Accord: Picker X-Ray Corp. v. Frerker, 405 F.2d 916, 923 (8th Cir. 1969) (citing *Palmer*); *Chadwell v. Koch Refining Company*, 251 F.3d 727 (8th Cir. 2001) (endorsing *Scheerer*): *Paddack v. Dave Christensen, Inc.*, 745 F.2d 1254, 1258-59 (9th Cir. 1984) (citing *Palmer*); *Timberlake Constr. Co. v. U.S. Fidelity and Guaranty Co.*, 71 F.3d 335, 341-43 (10th Cir. 1995) (citing *Palmer*). Nontestifying expert Ojala's DNA test report therefore is not an admissible Rule 803(b) business record.

Testifying expert Koppatschek authored only two sentences in his report that related to DNA testing, simply reiterating Ojala's DNA test conclusions about the extent to which seed in David's fields contained the '605 DNA sequence. (¶ 11, *supra*, p. 4-5) The Panel's opinion held that, "Koppatschek's reliance on the scientific reports prepared by his team is therefore the type of reliance that is reasonable for expert witnesses [under Rule 703]." 516 F.3d at 1015. Because "his team" did not testify and "his team" prepared the DNA report *for purposes of litigation*, the Federal Circuit's *en banc* endorsement of the holding conflicts with decisions of the Eighth Circuit, and other Circuit Courts of Appeal. The court in *United States v. Tran Trong Cuong, M.D.*, 18 F.3d 1132, 1143-44 (4th Cir. 1994), explained the principle:

> Reports specifically prepared for purposes of litigation are not, by definition, "of a type

> reasonably relied upon by experts in the particular field."

The Eighth Circuit Court of Appeals in *United States v. Greybear*, 883 F.2d 1382, 1392-93 (1989), recognized this principle when it held:

> [Appellants] first contend that the district court erred in failing to permit their expert witness, Dr. Jerry Baldwin, to state that the opinions of two other pathologists agreed with his own. We are persuaded that Fed.R.Evid. 703 does not permit an expert witness to circumvent the rules of hearsay by testifying that other experts, not present in the courtroom, corroborate his views.

The Seventh Circuit Court of Appeals upheld the same principle in *James Wilson Associates, Debtor*, 965 F.2d 160, 173 (1992) (citing *Greybear*), when it explained that a testifying architect could not "becom[e] in short the [nontestifying] engineer's spokesman" and then disallowed "the kind of hand-off attempted in this case." *Accord: Linn v. Fossum*, 946 So.2d 1032, 1038-1039 (Fla. 2007) (applying state rule identical to FRE 703) ("[If] the sources are an expert witness's colleagues who have responded to a case-specific inquiry by the expert...[t]he opposing party is unable to cross-examine the nontestifying experts...").

Further, under Rule 703, the fact that Koppatschek relied on Ojala's inadmissible hearsay report does not transform the report into substantive evidence. *Boone v.* Moore, 980 F.2d 539, 542 (8th Cir. 1992) ("unless the particular evidence is otherwise admissible under the

Rules of Evidence, it may not come in as substantive evidence."); *Barrett v. Acevedo*, 169 F.3d 1155, 1163, n. 7 (8th Cir. 1999) ("This type of evidence is never admitted for the truth of the matter asserted, but simply to show a basis for an expert's opinion.") (citing *Boone*); *United States v. Tran Trong Cuong, M.D.*, 18 F.3d 1132, 1143-44 (4th Cir. 1994) ("Even though an expert witness may base his opinion on underlying information, it does not follow that the otherwise inadmissible information may come into evidence just because it has been used by the expert in reaching his opinion.")

An expert is not permitted to render an opinion based exclusively upon inadmissible facts or data, and such an opinion does not create a fact issue. *TK-7 Corp. v. Estate of Barbouti*, 993 F.2d 722, 732 (10th Cir. 1993) ("The fact that [the expert] relied upon the [inadmissible] report in performing his calculation of lost profits did not relieve the plaintiffs from their burden of proving the underlying assumptions contained in the report."); *In re Lake State Commodities, Inc.*, 271 B.R. 575, 584-585, 587 (N.D. Ill. 2002) (no fact question generated on Ponsi Scheme issue when only evidence was expert who relied solely on opinion of nontestifying expert). Monsanto admitted Ojala's test conclusions were "crucial" to proof of its infringement claim. (¶ 13, *supra*, p. 6-7)

None of the cases cited by the Panel in its opinion involved an expert testifying to the results of tests performed for the purposes of the litigation by another of the same party's paid but nontestifying expert. *See* 516 F.3d at 1015; App. 11a. In *Data Line Corp. v. Micro Techs., Inc.*, 813 F.2d 1196, 1200-1201 (Fed. Cir.

1987), the plaintiff's experts testified about schematic drawings of the patented device "from various sources" that were pre-litigation and did not testify on the basis of reports or drawings prepared for purposes of litigation by the same party's nontestifying expert. *Sweet v. United States*, 687 F.2d 246, 249-250 (8th Cir. 1982), dealt with challenges to expert *qualifications*; neither of the challenged government psychiatric expert witnesses testified on the basis of any test or report prepared for the purposes of litigation by a nontestifying expert. In *Ratliff v. Schiber Truck Co.*, 150 F.3d 949, 952-953, 955 (8th Cir. 1998), the plaintiff's expert admitted on direct he relied in part on a police report and the court merely upheld a ruling allowing defendant's attorney to *cross-examine* the plaintiff's expert on report conclusions adverse to the plaintiff. In *Gussack Realty Co. v. Xerox Corp.*, 224 F.3d 85, 94-95 (2nd Cir. 2000), the plaintiff's expert testified on the basis of tests performed by the defendant's *own* experts and pre-litigation tests performed by the state environmental agency in its regulatory capacity. None of the Panel's cases admitted testimony given by a party's paid expert in "reliance on ... scientific reports prepared by his team ... ", the tactic approved by the Federal Circuit.

Without testifying expert Koppatschek's regurgitation of nontestifying expert Ojala's DNA sequence test report conclusion, Monsanto had no evidence of how much RR seed was allegedly planted in Petitioner's fields, so Monsanto's circumstantial evidence case fails for lack of a "crucial" element. It is important for the Supreme Court to give the circuit courts of appeal and district courts guidance on the correct application of FRE 803(6) and 703 to testimony

of an expert retained for purposes of litigation that reiterates a report prepared for purposes of the litigation by another nontestifying retained expert.

III. This Court Should Review Whether a Federal Statutory Award of Attorney Fees, Expert Expenses, and Costs in a Private Law Action (Not a Civil Rights Action Involving Important Civil and Constitutional Rights Providing a Broader, Uncompensated Benefit to the Public), in the Amount of $487,000, Is Reasonable in Relation to the Result Achieved, a Compensatory Damage Award of $226,000.

A. The question is important.

Once again the Federal Circuit's denial of rehearing *en banc* makes its decision on this issue its entrenched position. And also once again, the Federal Circuit's decision is in conflict with Supreme Court precedent. *City of Riverside v. Rivera*, 477 U.S. 561, 574-575, 578, 585-587, 591-593 (1983); *Farrar v. Hobby*, 506 U.S. 103, 114-116 (1992). This is a trigger factor for certiorari review of a Federal Circuit decision. *Supreme Court Practice*, at 287, *supra*, p. 2. Since the Federal Circuit Panel acknowledged that Petitioner asserted this appeal point (516 F.3d at 1016; App. 13a), but without explanation *failed to address it*, Supreme Court precedent on this issue apparently was not clear to the Panel or the Circuit *en banc*. Clarifying Supreme Court precedent on this issue is also a basis for granting certiorari. (*Supra*, p. 10)

It is important that the Supreme Court resolve this question because it resonates far beyond fee awards in patent cases. Resolution of this question here will instruct all federal district and circuit courts on correct application of all non-civil rights statutes authorizing fee awards.

In addition, the decision of the Federal Circuit (which has exclusive jurisdiction of all patent claims, except counterclaims) conflicts with decisions of the Fourth and Fifth Circuits.

B. The Federal Circuit decided the question incorrectly.

The Federal Circuit Panel ruled that the District Court's $226,000 compensatory damage award was clearly erroneous because the planting rate assumed by the District Court was too great, and remanded for reduction of the award. Monsanto claimed only damages for a *one year license* to David to plant saved seed during 2003. It never pleaded or charged David transferred saved seed to another person. The Federal Circuit Panel nevertheless awarded a hypothetical negotiated royalty of $55.04 per unit for the 4,110 units the District Court found Petitioner planted unlawfully.

The Panel's opinion acknowledged that Petitioner's third challenge to the fees and costs awarded was that the amount awarded "does not bear a reasonable relation to the results achieved..." 516 F.3d at 1016; App. 13a. Not only did the Panel fail to address the cases Petitioner cited in support of David's challenge, the Panel failed to address the issue at all.

Other circuit courts of appeal have recognized that in private law actions the amount of an attorney fee award must be reasonable in comparison to the amount of the damage award. In *Thomas v. Peacock*, 39 F.3d 493, 506 (4th Cir. 1994) (remanded for recalculation of damages), the court contrasted fee awards in civil rights cases where fee shifting statutes are intended to provide an incentive for "private attorneys general" to enforce the statute, with private law actions such as ERISA actions (and here patent infringement actions) in which there is no statutory purpose of creating "private attorneys general." *Accord*: *Iron Workers Local No. 272 v. Bowen*, 624 F.2d 1255, 1265-66 (5th Cir. 1980) (plaintiffs in civil rights actions are "private attorneys general", but that purpose does not carry over to private law actions); and *see*, *McNeil-PPC, Inc. v. L. Perrigo Company*, 337 F.3d 1362, 1372 (Fed. Cir. 2003) ("...[a]ttorney fees are not to be routinely assessed against a losing party in litigation in order to avoid penalizing a party 'for merely defending or prosecuting a lawsuit.'").

The Federal Circuit's position conflicts with *City of Riverside v. Rivera*, 477 U.S. 561, 574-575, 578, 585-587, 591-593 (1986). In *Riverside*, Justice Brennan's plurality opinion (three justices joined in the opinion, and Justice Powell concurred only in the judgment), in discussing reasonable fee factors in a civil rights case, said "The amount of damages a plaintiff recovers is certainly relevant to the amount of attorney's fees to be awarded under § 1988." 477 U.S. at 574. The opinion pointed out, however, that this was only one factor in civil rights cases because "Unlike most private tort litigants, a civil rights plaintiff seeks to

vindicate important civil and constitutional rights that cannot be valued solely in monetary terms." *Id.*

The *Riverside* plurality opinion by Justice Brennan explained at 477 U.S. 575:

> Because damages awards do not reflect fully the public benefit advanced by civil rights litigation, Congress did not intend for fees in civil rights cases, unlike most private law cases, to depend on obtaining substantial monetary relief.
>
> ****
>
> Congress recognized that reasonable attorney's fees under § 1988 are not conditioned upon and need not be proportionate to an award of money damages.

At 477 U.S. 578, the plurality continued its explanation of why proportionality between statutory fees and monetary damages recovered was not always desirable in civil rights cases:

> A rule of proportionality would make it difficult, if not impossible, for individuals with meritorious civil rights claims but relatively small potential damages to obtain redress from the courts. This is totally inconsistent with Congress' purpose in enacting § 1988.

Justice Powell's concurring (in the judgment only) opinion also recognized the importance of a reasonable relation between fees awarded and the amount recovered where the "recovery of private damages is

the purpose" of the case rather than "the vindication of constitutional rights in addition to the amount of damages recovered." 477 U.S. at 585. Thus all five Justices forming the *Riverside* majority endorsed the proportionality principle where public benefits are not sought.

Four justices dissented in *Riverside* because they believed the case did *not* achieve such non-monetary constitutional public benefits and therefore should be judged as if it was a private law action. Justice Rehnquist's dissent said:

> In the private sector, "billing judgment" is an important component in fee setting. It is no less important here. Hours that are not properly billed to one's *client* also are not properly billed to one's *adversary* pursuant to statutory authority. 461 U.S. at 434, 103 S.Ct. at 1940, quoting *Copeland v. Marshall*, 205 U.S. App. D.C. 390, 401, 641 F.2d 880, 891 (1980) (en banc) (emphasis in original).

Justice Rehnquist's dissent explained at 477 U.S. 593:

> If A has a claim for contract damages in the amount of $10,000 against B, and retains an attorney to prosecute the claim, it would be both extraordinary and unjustifiable, in the absence of any special arrangement, for the attorney to put in 200 hours on the case and send the client a bill for $25,000. Such a bill would be "unreasonable," regardless of whether A obtained a judgment against B for $10,000 or obtained a take-nothing judgment...any

> competent attorney, whether prosecuting or defending a contract action for $10,000, would realize that the case simply cannot justify a fee in excess of the potential recovery on the part of either the plaintiff's or the defendant's attorney.... The very "reasonableness" of the hours expended on a case by a plaintiff's attorney necessarily will depend, to a large extent, on the amount that may reasonably be expected to be recovered if the plaintiff prevails.

Thus all nine justices in *Riverside* supported the principle that in a private law action, any award of fees and costs must be reasonable in relation to the monetary damages obtained. *Accord: Farrar v.* Hobby, 506 U.S. 103, 114-116 (1992); *Silverman v. CBS, Inc.*, 675 F.Supp. 870, 871 (S.D.N.Y. 1988), *affirmed in part, vacated in part* (fee reduction affirmed) 870 F.2d 40 (2nd Cir. 1989), *cert. denied,* 492 U.S. 907 (1989) (copyright case, $185,887 in fees requested on $9,403 recovery, $10,000 fee award); *Bemis v. Hogue*, 935 F.2d 269, 1991 WL 102385, p. 6 (6th Cir. 1991) ($17,425 fee request, $2,500 awarded); *In re South Dakota Microsoft Antitrust Litigation*, 707 N.W.2d 85, 108 (S.D. 2005) (fee award of $2,064,000 "has no reasonable relation to the $466,000" recovery).

Any question after *Riverside* about whether statutory attorney fees must be reasonably related to the money damages recovered, where no broader public benefit is achieved, should have been put to rest in *Farrar v. Hobby*, 506 U.S. 103 (1992). In *Farrar*, plaintiff's suit obtained a jury verdict that plaintiff had been deprived of a civil right but plaintiff was awarded only nominal damages. 506 U.S. at 106-107. The

district court nevertheless awarded attorney fees and expenses of $307,000. The Fifth Circuit reversed the fee award and denied award of any fees because there was only "a nominal award of one dollar ... nor was the result a success for the [plaintiff] on a 'significant issue ...'" *Estate of Farrar v. Cain*, 941 F.2d 1311, 1315 (5th Cir. 1991). In affirming the Fifth Circuit's denial of fees, Justice Thomas' majority opinion in *Farrar v. Hobby*, said:

> Where recovery of private damages is the purpose of ... civil rights litigation, a district court, in fixing fees, is obligated to give primary consideration to the amount of damages awarded as compared to the amount sought." *Riverside v. Rivera*, 477 U.S. 561, 585, 106 S.Ct. 2686, 2700, 91 L.Ed.2d 466 (1986) (Powell, J. concurring in judgment). Such a comparison promotes the court's "central" responsibility to "make the assessment of what is a reasonable fee under the circumstances of the case." *Blanchard v. Bergeron*, 489 U.S. 87, 96, 109 S.Ct. 939, 946, 103 L.Ed2d 67 (1989).

506 U.S. at 114-115.[3] The Supreme Court criticized the district court at 506 U.S. 115-116:

> In an apparent failure to heed our admonition that fee awards under § 1988 were never intended to "'produce windfalls to attorneys,'" *Riverside v. Rivera*, *supra*, 477 U.S., at 580, 106

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[3] Justice O'Connor's concurrence joined in Justice Thomas' opinion and concurred in the judgment. 506 U.S. at 116.

> S.Ct. at 2697 (plurality opinion) (quoting S.Rep. No. 94-1011, p. 6 (1976) U.S. Code Cong. & Admin. News 1976 pp. 5908, 5913), the District Court awarded $280,000 in attorney's fees without "consider[ing] the relationship between the extent of success and the amount of the fee award." *Hensley, supra*, 461 U.S., at 438, 103 S.Ct., at 1941.

Thus, in a civil rights case which does not achieve a significant public benefit in addition to monetary damages a statutory award of attorney fees must be reasonably related to the monetary award obtained. The same reasonable relationship is clearly required in a private patent action benefitting only Monsanto.

The Panel further erred when it said, "...we reject David's argument that the attorney fees and costs stipulated to in the Technology Agreement are limited by statute."[4] (App. ____) Again, the Panel's opinion did not address David's cases. When the finding of a breach of contract depends upon whether a patent was infringed, 35 U.S.C.A. § 285 governs the extent to which the district court may award attorney fees. *Interspiro U.S.A., Inc. v. Figgie International, Inc.* 18 F.3d 927, 933 (Fed. Cir. 1994). Monsanto's claimed contract breach is that David infringed the '605 Patent. Therefore 35 U.S.C.A. § 285 and 28 U.S.C.A. §§ 1920 and 1821 (b) govern the extent of any award of attorney fees and costs. This is a specific remedy

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[4] The back page of the Technology Agreement states, "These Monsanto gene technologies are protected under U.S. patent law...." (A45-46)

allowed by Title 35 and the remedy cannot be enlarged by a contract between private parties. The court in *Connolly v. Pension Benefit Guaranty Corp.*, 475 U.S. 211, 223-224 (1986), instructed:

> Contracts may create rights of property, but when contracts deal with a subject matter which lies within the control of Congress, they have a congenital infirmity. Parties cannot remove their transactions from the reach of dominant constitutional power by making contracts about them." *Norman v. Baltimore & Ohio R. Co.*, 294 U.S. 240, 307-308, 55 S.Ct. 407, 415-16, 79 L.Ed. 885 (1935).
>
> If the regulatory statute is otherwise within the powers of Congress, therefore, its application may not be defeated by private contractual provisions.

Accord: B & G Enterprises, LTD. v. United States, 220 F.3d 1318, 1323 (Fed. Cir. 2000) (quoting *Connolly*); *United States v. Blue Cross / Blue Shield of Alabama*, 999 F.2d 1542, 1547 (11th Cir. 1993) (quoting *Connolly*).

Existing statutory provisions are as much a part of a contract as if they had been included in the contract. *Norfolk & Western Railway Co. v. American Train Dispatchers' Assn.*, 499 U.S. 117, 129-130 (1991); *Wheeling Pittsburgh Steel Corp. v. Beelman River Terminals, Inc.* 254 F.3d 706, 713 (8th Cir. 2001). Monsanto accepted Title 35 benefits of the '605 patent. Monsanto cannot use a private contract to avoid the limitations imposed by Title 35 and Title 28 on the

remedies Congress has specifically allowed and limited.

Monsanto would not incur these extraordinary attorney fees and expenses unless it thought that by using Petitioner as an example of what Monsanto can do to a farmer, Monsanto could increase revenues enough to justify these excessive expenditures. Petitioner is not obligated by § 285 to finance the cost of Monsanto's business plan.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully Submitted,

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